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JUN 25 2007

In re Application of
Frederick L. Bixler, Doug
Coners, and Don Rochow

Application No. 10/752,074
Filed: January 5, 2004
Title: TAMPER INDICATING
CLOSURE WITH FOLDABLE TAB

OFFICE OF PETITIONS

DECISION ON TWO PETITIONS
PURSUANT TO 37 C.F.R. §§
1.47 (A) AND 1.48 (A)

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed May 8, 2007. This is also a decision on the concurrently filed petition under 37 C.F.R. §1.48(a)².

1 A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130, if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(f);
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that either:
 - a) a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application, or
 - b) the non-signing inventor cannot be found or reached after diligent effort, and a statement that these efforts were not successful;
- (5) a declaration which complies with 37 CFR § 1.63.

2 A grantable petition under 37 C.F.R. §1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

The petition pursuant to Rule § 1.47(a) is **DISMISSED**.

The petition pursuant to Rule § 1.48(a) is **DISMISSED**.

On January 5, 2004, the application was filed, identifying Frederick L. Bixler, Doug Coners, and Don Rochow as joint inventors. The application was deposited without an executed declaration. On October 7, 2004, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice) was mailed, requiring, *inter alia*, a fully executed oath or declaration and the surcharge associated with the late submission of the same. This Notice set a two-month period for reply.

On May 12, 2005, a partially executed declaration was provided to the Office, along with the surcharge associated with the late submission of the same, and a five-month extension of time. It is noted that the submission contains a certificate of mailing dated May 9, 2005, and that May 7, 2005 fell on a Saturday.

The present petitions were not filed until two years later, on May 8, 2007.

With the present submissions, Petitioner has included a declaration that has been signed by David Krueger and Frederick Bixler, along with a request to add Mr. Krueger as a joint inventor.

The petition pursuant to Rule § 1.47(a):

With this petition, Petitioner has met requirements (1) - (3) of Rule § 1.47(a).

Regarding the fourth requirement of Rule § 1.47(a), Petitioner has suggested that neither Mr. Coners or Mr. Rochow can be located, and that Petitioner has been "unable to locate a current telephone number, e-mail address and mailing address for either of them³."

It does not appear that Petitioner has provided any **details of the efforts to obtain this information**. Petitioner must provide a showing detailing the attempts that were made to obtain a

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

3 Helfert declaration.

forwarding address or to locate the non-signing inventor by means such as through E-mail, telephone, or the Internet. If it is then averred that such attempts failed, then applicant will have provided the necessary proof required under 37 C.F.R. § 1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details.

Regarding the fifth requirement of Rule §1.47(a), the declaration that was submitted concurrently with the present petition cannot be accepted, as it is defective. The declaration is defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56. Instead of "material to patentability," it improperly states "**material to the examination of this application**," which has no meaning in the context of the rule.

The petition pursuant to Rule § 1.48(a):

Petitioner has provided a request to correct the inventorship that sets forth the desired inventorship change, along with a statement from the person being added as an inventor.

However, Petitioner has **failed to comply with Rule §1.48(a)(3)**, in that the declaration that Petitioner has submitted does not appear to have been executed by Messrs. Coners and Rochow. As it does not appear that Petitioner has been able to secure their signatures on this document, Petitioner may wish to file a petition pursuant to Rule § 1.183, requesting the waiver of Rule § 1.48(a)(3).

Furthermore, as noted above, the **declaration** that was submitted with the present petition is defective.

Any renewed petition must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.47(a) and 1.48(a), and Petition Under 37 C.F.R. § 1.183." This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be

submitted by mail⁴, hand-delivery⁵, or facsimile⁶. If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - the inclusion of any additional information will delay the delivery of the response to the undersigned. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.